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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,255	03/05/2002	Don R. LaBonte	01A10 LaBonte	6800

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PATENT DEPARTMENT
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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 04/08/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,255

Applicant(s)

LA BENTE

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on application filed 3/5/02.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/5/02 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

K. L. Bell

Detailed Action

Title

The following title is suggested: --Sweetpotato Plant Named 'L96-117'--. The title should be directed to the plant.

Objection to the Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to pages 4 and 6 of the oath or declaration. See 37 CFR 1.52(c).

Objection to the Drawing

The submitted photographic illustrations filed March 5, 2002 are objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October

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1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at: <http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>.

Further, the drawings should not be sent to the 20231 zip code address for the United States Patent and Trademark Office. Please direct all replies to the United States Patent and Trademark Office via one of the following:

1. Hand carried directly to:
1911 South Clark Place
Crystal Mall One, 7th Floor Receptionist Area
Arlington, Virginia 22202
2. Mailed to:
U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, Virginia 22202

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

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A. Page 1, lines 2-5 should be deleted as the information set forth is unnecessary in the specification.

B. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the claimed plant and Variety Denomination of the claimed plant should be preceded by a heading as set forth in 37 CFR 1.163(c)(4)(5) and 37 CFR 1.163(d). This information should be set forth before line 6 of page 1 as set forth in 37 CFR 1.163(c).

C. Page 1, line 8, Applicants have stated that the instant plant has been identified as “L96-117 Sweetpotato” (“L96-117”). The instant plant has to have a name designation. However, it is uncertain if applicant intends the cultivar name to be ‘L96-117 Sweetpotato’ or ‘L96-117’. It appears applicant is intending ‘L96-117’ as the cultivar name. If such is accurate, applicant should set forth the cultivar name not “L96-117 Sweetpotato” as it is obvious what type of plant is being described in the specification by the title of the application. Further, applicant should place single quotations marks around the cultivar name as this is the proper way to designate a cultivar name. Correction and/or clarification is necessary.

D. Page 1, line 9, and Page 2, lines 8-10, Applicants state the instant plant was “developed from a seedling produced in a polycross nursery” and provides lineage of what

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appears to be a female parent. This recitation does not meaningfully set forth the origin of the instant plant. Applicants state the instant plant was produced from a "seedling". It is unknown whether the instant plant was a naturally occurring mutation of this seedling, an induced mutation of this seedling, or a self pollination of the seedling used to produce the instant plant, or something else.

Plants can be created by crossing two plants, a naturally occurring mutation of a plant (either whole plant or branch, etc.), or an induced mutation (irradiation, etc.). Applicants should meaningfully set forth in the specification the origin of the instant plant (MPEP 1605). The origin of the plant must be clearly and unambiguously set forth.

E. Applicants are requested to set forth in the specification whether the parental cultivar(s) (if known) has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

F. Applicants should import into the specification comparative information between the instant plant and the parental cultivar(s), or both parental cultivars if there was more than one

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parental cultivar, such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.

G. Page 1, line 11, Applicants should insert --known to the inventors-- or --known to us-- after “varieties” as it is in the realm of possibility that another sweetpotato with both superior processing qualities and high total-sugar content exists unknown to the inventors.

H. Applicants are requested to set forth in the specification whether the cultivars ‘Beauregard’ (or ‘Beauregard sweetpotato’, whichever is the cultivar name) and ‘Jewel’ have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

I. Page 2, lines 3-5 should be deleted as these recitations are usually set forth in a U.S. Plant Patent application transmittal form.

J. Page 2, lines 12-15, Applicants should set forth in the specification the age of the plants when described, and container size (if grown in a container).

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K. Applicants should set forth in the specification the typical and observed plant height and diameter/spread.

L. Applicants should set forth in the specification information relative to the instant plant's lateral branches including the typical and observed number of lateral branches, length, diameter, internode length, and coloration with reference to the employed color chart.

M. Applicants should set forth in the specification information relative to the instant plant's stem including the typical and observed stem length, diameter, and coloration with reference to the employed color chart.

N. Page 2, line 20 to page 3, line 3, Applicants should set forth in the specification additional information relative to the instant plant's foliage including the typical and observed leaf shape, length, width, margin descriptor, and mature upper and lower surface coloration with reference to the employed color chart.

O. Page 2, lines 23-25, Applicants state the unfolded immature leaves are "purple-edged" with "purple" adaxial veins and that the abaxial veins remain mostly "purple" as they mature and that the adaxial veins are mostly "green" with some "purple". The recitations "purple-edged",

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“purple”, and “green” are vague and insufficient in this regard. Applicants should set forth in the specification color designations for the “purple-edged”, “purple”, and “green” colorations along with the typical and observed color designation(s) for the immature leaf upper and lower surfaces with reference to the employed color chart.

P. Page 2, line 26 and page 3, line 1, Applicants state the immature petiole is “light purple” which turns “green”. The recitations “light purple” and “green” are vague and insufficient in this regard. Applicants should set forth in the specification color designations for the “light purple” and “green” colorations with reference to the employed color chart.

Q. Page 2, line 26 and page 3, line 1, Applicants should set forth in the specification additional information relative to the instant plant’s petiole including the typical and observed petiole length and diameter.

R. Page 3, lines 1 and 2, Applicants “purple” joint and the node from which the petiole attaches to the stem is also “green”. The recitations “purple” and “green” are vague and insufficient in this regard. Applicants should set forth in the specification color designations for the “purple” and “green” colorations with reference to the employed color chart.

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S. Page 3, line 6, The “R” trademark symbol is unnecessary and should be deleted.

T. Page 3, line 8, The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicants are required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

U. Page 3, Table 1, Applicant has set forth numbers in parentheses. Some of the numbers set forth have letters placed after them such as “1.41 YR”. However, most of the number set forth like this do not have letters set forth after them. These letters appear to be color designations. If such is accurate, applicants should provide the appropriate letters after all the numbers within parentheses as these letters are necessary to determine the color value intended. Correction and/or clarification is necessary.

V. Applicants should set forth in the specification the typical and observed time it takes to produce a harvest.

W. Applicants should set forth in the specification additional information relative to the instant plant’s storage roots, i.e. sweetpotato, including the typical and observed shape, length, diameter, apex and base descriptors, and weight.

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X. If produced, applicants should set forth in the specification information relative to the instant plant's inflorescence including the typical and observed type of inflorescence and number of flowers per inflorescence.

Y. If produced, applicants should set forth in the specification information relative to the instant plant's flower buds including the typical and observed bud shape, length, diameter, and coloration with reference to the employed color chart.

Z. If produced, applicants should set forth in the specification information relative to the instant plant's flowers including the typical and observed corolla diameter and depth, and fragrance, petal number, shape, length, width, apex, base, and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

AA. If produced, applicants should set forth in the specification information relative to the instant plant's sepals including the typical and observed sepal number, shape, length, width, apex and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

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AB. If produced, applicants should set forth in the specification information relative to the instant plant's peduncle including the typical and observed peduncle length, diameter, and coloration with reference to the employed color chart.

AC. Applicants should review MPEP 1605, 37 CFR 1.163© for the purpose of setting forth specific sections in the specification.

AD. The following claim is suggested: --A new and distinct variety of *Ipomoea batatas* plant named 'L96-117', as illustrated and described.--.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

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Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicants file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicants should specifically authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

Applicants should note the new amendment format which is permitted now but will become mandatory this summer (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

KENT BELL
PRIMARY EXAMINER

Kent L. Bell